

**AMENDMENTS TO THE DRAWINGS**

The attached sheet(s) of drawings includes changes to Figures 9A and 9B and 10 wherein "Conventional Art" has been removed.

Attachment: Replacement sheets

Annotated sheet showing changes

### **REMARKS**

Applicants thank the Examiner for the thorough examination of the application. A Declaration under 37 C.F.R. §1.132 is attached to this paper. No new matter is believed to be added to the application by this amendment.

### **Status of the Claims**

Claims 1-25 are pending in the present application. Claims 1, 4, 8, 13 and 15 are independent claims.

### **Amendments To The Drawings**

Figure 9A and Figure 9B have been amended to remove the legend "Conventional Art," which represents a typographical error in the translation of the priority document. Attached, please find a Declaration under 37 C.F.R. §1.132 attesting to the inventive nature of the subject matter of Figure 9A and Figure 9B. An executed Declaration is expected to follow.

### **Rejections Under Based On Kuba**

Claims 1-11 and 13-25 are rejected under 35 U.S.C. §102(b) as being anticipated by Kuba (U.S. Patent 5,806,072). Claim 12 is rejected under 35 U.S.C. §103(a) as being obvious over Kuba in view of what the Examiner alleges is the Applicants' admitted prior art. Applicants respectfully traverse.

*The Present Invention And Its Advantages*

The present invention pertains to a file management system for a rewritable digital reversible disk (DVD). The present invention copies real-time data stream files on rewritable discs that determines if a file name and/or directory change will render impossible the reproduction of real-time data files in the disk-recording medium (such as a DVD). The disk technology of the present invention finds a typical embodiment in instant claim 1, which sets forth:

1. A file managing method in reproducing a rewritable disk, comprising the steps of:
  - (a) checking the file names, directories, or names and directories of files written in the rewritable disk;
  - (b) providing a message indicating that reproduction is impossible when the file names, directories, or names and directories are against a standard file scheme pre-specified for a disk containing real-time data; and
  - (c) conducting a correction operation, if demanded.

The invention can further include the step of, before the step (a), inserting the rewritable disk containing real-time data stream files into a disk device.

As a result, the file managing method for real-time data file according to the present invention notifies a user of the reason why disk reproduction fails and corrects a wrong file scheme, if wanted, drawn up in a rewritable disk

when a file containing real-time data stream is requested to be recorded, thereby preventing reproduction failure which would be caused from an inadequate file name or directory.

*Distinctions Of The Invention Over Kuba*

Distinctions of the invention over Kuba have been placed before the Examiner at pages 9-11 of the Amendment filed February 22, 2005. For brevity, this discussion is not repeated here.

Kuba utterly fails to disclose or suggest a file management method for a disk such as a DVD.

At page 4 of the Office Action, the Examiner asserts that Kuba pertains to file management on a rewritable disk (column 27, lines 5-25, column 31, lines 30-350). However, Kuba does not pertain to a disk but instead pertains to a memory card. This is clearly evident by the "memory card" discussed at *inter alia* column 26, lines 14, 44, 58, 63 and 66 of Kuba. Also, column 28, lines 1-10 of Kuba, upon which the Examiner admittedly relies, recites a "memory card" at line 6.

Further, the Examiner in his Response to Arguments at page 2 of the Office Action asserts that column 31, lines 30-35 of Kuba pertains to storing audio files, which the Examiner posits a being a type of real-time data stream. However, Column 31, line 30 of Kuba clearly recites a "card memory 71."

A memory card is not a disk. A memory card is a removable module that contains RAM chips (see, e.g., [www.pcmag.com/encyclopedia\\_term/0,2542,t=memory+card&i=46763,00.asp](http://www.pcmag.com/encyclopedia_term/0,2542,t=memory+card&i=46763,00.asp)). Where in the disclosure of Kuba is this technology applied to a disk?

That is, Kuba fails to teach each and every element of claim 1 of the present invention. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "All the words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

In contrast, claim 1 of the present invention typically recites (more than once) a "rewritable disk" (see also independent claims 4, 8, 13 and 15). Kuba thus fails to set forth each and every element of claims 1, 4, 8, 13 and 15 of the present invention. Claims depending upon these independent claims are patentable for at least the above reasons.

Then, the Examiner utilizes Kuba as the basis of an allegation of *prima facie* obviousness over claim 12. However, the failure of Kuba to disclose or suggest a technology for a rewritable disk is not addressed by the Examiner in alleging obviousness over the claimed invention. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or

suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Further, the Examiner is applying a memory card technology to a DVD. The memory card technology of Kuba is applied to cameras, where space requirements are of great concern. Installing a bulky DVD drive into a camera would render the camera so unwieldy as to render it unsuitable for its intended purpose. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Finally, the Examiner turns to the Applicants' own disclosure for teachings pertaining to a 1-byte type field. As has been pointed out, no admission of prior art has been made by the Applicants. However, at page 3, lines 8-10, the Examiner asserts: "Applicant amended Figure 9B in the correspondence filed 5/17/04 to explicitly make such an admission."

However, Figure 9B was amended to bear the legend "Conventional Art." First, the original labeling of Figure 9B as "Conventional Art" was a typographical error, as was pointed out at page 8 of the Amendment filed November 26, 2003. Figure 9B is being re-amended to remove the legend "Conventional Art," and a Declaration is being filed attesting to the inventive provenance of the subject matter of Figure 9B. Also, Figure 9A, which is

related to Figure 9B, has been amended to remove the erroneous "Conventional Art" label.

Also, even if "Conventional Art" was meant, this phrase does not have the same meaning as "Prior Art." The Merriam Webster Dictionary defines the word prior as "earlier in time or order." In contrast, the Merriam Webster Dictionary defines the word conventional as "commonplace, ordinary."

Further, one can assume for arguments sake that "Prior Art" was meant. What would be the result?

In *In re Nomiya*, the C.C.P.A. determined that even if there has been an admission of prior art, this admission of prior art will still not render an invention obvious if it points out the source of the problem that the invention solves.

It should not be necessary for this court to point out that a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is **part** of the "subject matter as a whole" which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103. *In re Antonson*, 47 CCPA 740, 272 F.2d 948, 124 USPQ 132; *In re Lennert*, 50 CCPA 753, 309 F.2d 498, 135 USPQ 307. The court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings. *In re Murray*, 46 CCPA 905, 268 F.2d 226, 122 USPQ 364; *In re Sporck*, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360. The issue, then is whether the teachings of the prior art would, **in and of themselves and without the benefits of the appellant's disclosure**, make the invention as a whole, obvious. *In re Leonor*, 55 CCPA 1198, 395

F.2d 801, 158 USPQ 20. (Emphasis in original) *In re Nomiya*, 509 F.2d 566, 571, 184 U.S.P.Q. 607, 612 (C.C.P.A. 1975).

In this case there has been no admission of prior art. Even if one assumes *arguendo* that the subject matter mislabeled as “Conventional Art” in Figure 9B is prior art, this disclosure depicts the problem that the invention solves. These teachings therefore provide no motivation to combine references.

If, as appellants claim, there is no evidence of record that a person of ordinary skill in the art at the time of the appellant’s invention would have expected the problem . . . to exist at all, it is not proper to conclude that the invention which solves this problem, which is claimed as an improvement of the prior art device, would have been obvious to that hypothetical person of ordinary skill in the art. 184 U.S.P.Q. 612, 613.

There is thus no motivation to combine the secondary reference of Kuba with the Applicants’ own disclosure. As a result, the claims are patentable because 1) the applicant’s disclosure is not usable to allege prior art, 2) there is no motivation to combine references even if the applicants’ disclosure could be used, and 3) Kuba’s failure to disclose or suggest a rewritable disk has not been addressed. A *prima facie* case of obviousness has thus not been made.

These rejections are accordingly overcome and withdrawal thereof is respectfully requested.



**Prior Art Cited But Not Used By The Examiner**

The prior art cited but not used by the Examiner show the status of the conventional art that the invention supercedes. No additional remarks are accordingly necessary.

**Conclusion**

For the foregoing reasons and in view of the above clarifying amendments, Applicants respectfully request the Examiner to reconsider and withdraw all of the objections and rejections of record, and earnestly solicit an early issuance of a Notice of Allowance.

Should there be any outstanding matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E. Goozner, Ph.D. (Registration No. 42,593) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

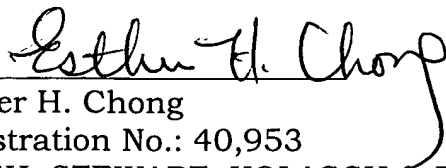
Application No. 09/779,556  
Preliminary Amendment filed December 21, 2005  
Response to After Final Office Action of June 21, 2005

Docket No.: 2950-0185P

Dated: December 21, 2005



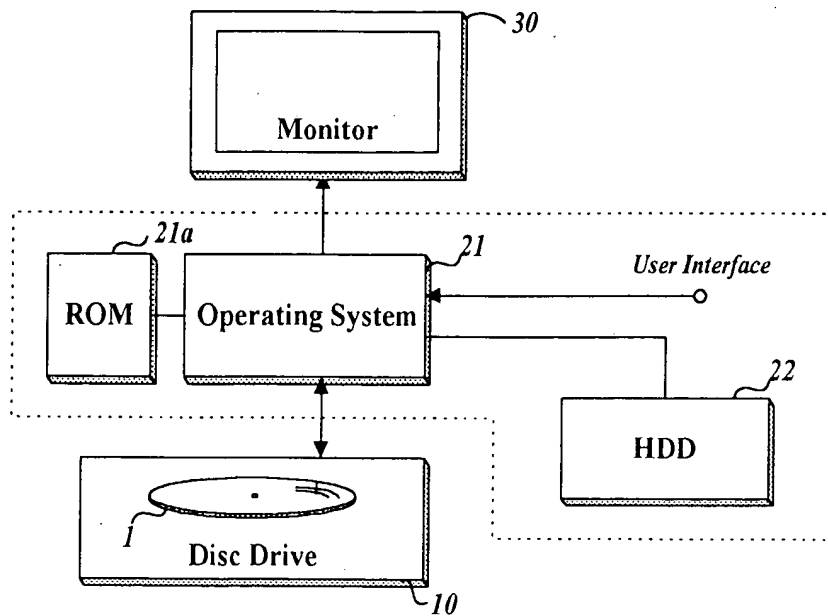
Respectfully submitted,

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FIG. 8



*Conventional Art*

FIG. 9A

File Entry		
RBP	Length	Name
0	16	Descriptor Tag
16	20	ICB Tag
36	4	Uid
⋮	⋮	⋮
176	L_EA	Extended Attributes
[ L_EA+176 ]	L_AD	Allocation Descriptors

*[[Conventional Art]]*



FIG. 9B  
[[Conventional Art]]

ICB Tag		
RBP	Length	Name
0	4	Prior Recorded Number of Direct Entries
4	2	Strategy Type
6	2	Strategy Parameter
8	2	Maxium Number of Entries
10	1	Reserved
11	1	File Type
12	6	Parent ICB Location
18	2	Flags

FIG. 10

File Type	
Type	Interpretation
0	Shall mean that the interpretation of the file is not specified by this field
1	Shall mean that this is an Unallocated Space Entry
...	...
249	Shall mean that this is real time file
250~255	Reserved for furture standardization